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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,629	03/23/2000	RAZI VAGO	229752001000	2656

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MORRISON & FOERSTER
2000 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20006-1888

EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/446,629

Applicant(s)

VAGO, RAZI

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claim Rejections

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4, 7, and 11 are rejected under 35 U.S.C. 101 because spacer form (claim 4, lines 2-3) is broad enough to encompass virtually any solid occupying a volume and hence *capable* of “spacing apart” two or more (unclaimed) elements; cylinder form, sleeve form, pin form, and curved plate form (claim 4, lines 2-3) are likewise broad enough to encompass *natural* shapes of coral skeletons, which are *capable* of being implanted or inserted into a large mammal (whale, elephant, etc.) in order, for example, to evaluate tissue response (for medical research) along an unaltered, structurally intact coral surface. An article of manufacture occurring in nature will not be considered patentable unless given a new form, quality, properties, or combination not present in the original article existing in nature (*Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 76 USPQ 280 (1948); *American Fruit Growers v. Brogdex*, 283 U.S. 1, 8 USPQ 131 (1931); *Ex Parte Grayson*, 51 USPQ 413 (Bd. App. 1941)). Under USPTO policy, any claim that is reasonably interpreted as covering embodiments which are statutory and embodiments which are non-statutory should be rejected. Regarding claim 11, the coral itself is viewed as an assembly of coral skeletons.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 7-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. In claim 4, line 1, “or related purposes” renders the claim indefinite as to the scope because it is not clear what the Applicant intends to cover by the recitation “*related purposes*” (emphasis added); attention is directed to MPEP § 2173.05(b), especially sections *C* and *F*. Similar problems occur in claims 11 and 14.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 7, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by AIMS, *CORAL GROWTH: Laser Based Underwater and Laboratory Measurements*, last updated on March 6, 1997. The species *Acropora grandis* possesses natural sizes and shapes *capable* of being implanted or inserted into a whale for medical purposes, such as studies on digestion or tissue response, and skeletal portions of said coral are *capable* of being implanted in humans, whether or not such was the intent. The naturally occurring structure meets all the limitations of claims 4, 7, and 11 for reasons explained in the above rejection under 35 U.S.C. 101.

Response to the Applicant's Remarks


The claims must be given their broadest reasonable interpretation (MPEP § 2111), and the interpretation of “spacer” was explained in the previous Office action of September 13, 2006, at page 3, lines 7-9. The Applicant's response does not overcome the grounds of rejection in a manner prescribed by MPEP § 2111.01 or elsewhere in the MPEP. The examiner has been informed by Mr. Hughes that during the telephone conversation with Mr. Bockman (as referenced in the Applicant's remarks of January 16, 2007, and February 6, 2007), Mr. Hughes

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stated that perhaps man-made articles were eligible for patent protection but did *not* say that articles, especially spacers, broad enough to read on naturally occurring articles were also patentable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762 and who is generally available Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Dave Willse
Primary Examiner
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